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08/819,669	03/17/1997	THIERRY BOON	LUD-5253.5-D	1995

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EXAMINER	
GAMBEL, PHILLIP	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LUDWIG INSTITUTE FOR CANCER RESEARCH

Appeal 2009-0273
Application 08/819,669
Technology Center 1600

Decided: January 16, 2009

Before RICHARD TORCZON, MICHAEL P. TIERNEY, and SALLY GARDNER LANE, *Administrative Patent Judges*.

TORCZON, *Administrative Patent Judge*.

DECISION ON APPEAL

All pending claims have been rejected. The appellant (Ludwig) seeks review of the rejection under 35 U.S.C. 134. We REVERSE.

CLAIMS ON APPEAL

Claims 183-191 are pending and have been rejected. When claims subject to the same rejection[1] are not argued separately, we select one of the rejected claims as the focus for our analysis.[2] We select claim 183 which defines the invention as follows:[3]

> An isolated, MAGE tumor rejection antigen precursor protein, wherein said protein is encoded by a nucleic acid molecule, the complementary sequence of which hybridizes to SEQ ID NO: 8 at 0.1xSSC, 0.1% SDS, wherein said tumor rejection antigen precursor is obtainable from melanoma cells.

THE REJECTION

The examiner rejected the claims as having been anticipated[4] or, alternatively, obvious[5] in view of a Chen patent[6] because "the applicants did not invent the claimed subject matter essentially for the reasons of record."[7]

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[1] While we are aware that the examiner has advanced alternative statutory bases for the rejection, both the examiner and Ludwig focus on the evidence of prior invention rather than on the niceties of anticipation versus obviousness. Indeed, the appeal brief only identifies the § 102(f) rejection as the rejection to be reviewed. Br. at 10. Hence, on this record, we treat the two bases as the same rejection.
[2] Bd.R. 37(c)(1)(vii).
[3] All claim language reproduced from the claims appendix of the appeal brief.
[4] 35 U.S.C. 102(f).
[5] 35 U.S.C. 103.
[6] *Tumor rejection antigen precursor*, U.S. Patent 5,843,448 (1998).
[7] Answer at 6.

The reasons of record are best summarized in one of the non-final rejections:[8]

> ...SEQ ID NO: 8 of the instant USSN 08/819,669 is the same sequence as SEQ ID NO: 1 disclosed in Example 5 of U.S. Patent No. 5,843,448 (see 892, mailed 3/28/01) (e.g., see Example 5 on columns 7-8 of U.S. Patent No. 5,843,448). The patented claims of U.S. Patent No. 5,843,448 are drawn to MAGE-1 tumor rejection antigen precursor proteins and immunogenic compositions, which anticipate the instant MAGE tumor rejection antigen precursor proteins and compositions thereof. * * *
>
> *Given…that no inventors are in common between the instant USSN 08/819,669 and [the Chen patent],*
>
> *there is ambiguity as to who invented the claims drawn to MAGE-1 and the MAGE tumor rejection antigen precursor proteins.*
>
> Because of this ambiguity, it is incumbent on applicants to provide a satisfactory showing [that] would lead to a reasonable conclusion that the instant listed inventors[] are the sole inventors of the claimed invention.

In the answer, the examiner noted:[9]

> With respect to the *inventorship in [the Chen patent*];
>
> it is noted that the Petition to Correct Inventorship ...was …granted 07/26/2007; which was over eight (8) years subsequent to the issue date for [the Chen patent].
>
> *Prior to 2007*, there was no inventor in common between [the Chen patent] and the instant USSN 08/819,669.

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[8] Office action at 4 (6 December 2006) (emphasis added).
[9] Answer at 14 (original emphasis).

FINDINGS

1 — The inventors for the Chen patent and the present invention are not the same.

2 — The Chen patent as issued listed seven inventors, all from New York or Germany.[10]

3 — The Chen patent was corrected in 2007 to add two inventors: Thierry Boon-Falleur and Pierre van der Bruggen.[11]

4 — The application on appeal lists as its inventors Boon-Falleur and van der Bruggen plus six different inventors from Belgium or Italy.

5 — Thus, Boon-Falleur and Pierre van der Bruggen represent an overlap in the inventors for the Chen patent and the present application.

6 — Ludwig does not in this appeal contest communication between any of the various relevant inventive entities.

ANALYSIS

An applicant may claim neither subject matter that "he himself did not invent"[12] nor subject matter that would have been obvious from the

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[10] Chen patent, cover.
[11] Chen patent, certificate.
[12] § 102(f). This provision has been distinguished from other forms of anticipation in requiring some channel of communication from the "real" inventor to the present applicant. *E.g.*, *Agawam Woolen Co. v. Jordan*, 74 U.S. (7 Wall.) 583, 602-03 (1868). Ludwig has not contested communication.

invention of another.[13] Named inventors, however, are presumed to be the correct inventors.[14]

Presumptions evaporate in the face of probative evidence.[15] The evidence of record shows that the Chen patent and the present application have different inventive entities and that the reported inventorship of the Chen patent was corrected by the granting of a petition in 2007. The presumption of correctness for inventorship places the burden squarely on the examiner to articulate a reason to doubt the inventorship. This burden *cannot* be very high since, necessarily, the applicant is in the best position to know the proper inventorship. The examiner must, however, provide some threshold basis for doubt.[16] The examiner's theory was two-fold. First, that there was no overlap in the inventorship, which ceased to be true when a petition to correct the Chen patent was granted. Second, that there was no overlapping inventorship before 2007. This second theory is the only one to survive into appeal.

The premise of the second theory is flawed. A correction means that the state-to-be-corrected has been found to be in error. The inventorship did

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[13] *Agawam Woolen Co.*, 74 U.S. at 602-03; *see also* § 103(c)(1) (excluding some situations not established on this record).
[14] *Cook Biotech Inc. v. ACell Inc.*, 460 F.3d 1365, 1381 (Fed. Cir. 2006). Ludwig cites (Br. at 13) older precedent for the proposition that a higher evidentiary standard also applies. The Supreme Court, however, foreclosed such arguments, holding that the preponderance standard applies in all Federal civil proceedings, even those involving allegations of fraud. *Grogan v. Garner*, 498 U.S. 279, 288-89 (1991).
[15] *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1579 (Fed. Cir. 1984).
[16] *Cf. Hyatt v. Dudas*, 492 F.3d 1365, 1369-70 (Fed. Cir. 2007) (noting the initial burden is a procedural device, not an insurmountable barrier).

not change in 2007, instead the listed inventors did. The corrected listing is itself presumed to be correct.[17] Thus, the burden lies squarely with the examiner to adduce some additional reason why the inventorship for the claims of the present application is wrong. The examiner's finding that there was no overlapping inventorship before 2007 is technically wrong.

We understand the examiner's ill-ease with the evolving inventorship in the present case. The differences in inventorship raise several reasonable questions such as—

> Why are there more than the two overlapping inventors for the present invention?
>
> Should the double-patenting rejection have been withdrawn?

Fortunately, to the extent the examiner considers these questions unanswered on the present record, he has tools at his disposal to compel answers, including reinstating the double-patenting rejection or seeking additional evidence[18] regarding the inventorship. The Board, however, lacks a basis in the record to pursue any of these possibilities.

HOLDING

The rejection of claims 183-191 under both § 102(f) and § 103 is—

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[17] *Winbond Elec. Corp. v. Int'l Trade Comm'n*, 262 F.3d 1363, 1371 (Fed. Cir. 2001). We decline to read the rejection as suggesting an error in the petition decision without some new evidence or showing of a clear flaw.

[18] *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1284 (Fed. Cir. 2005) (explaining why a burden shift can make sense procedurally when the applicant has the best access to the relevant facts).

REVERSED

ack

cc:

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